

## **REMARKS**

Claims 1-7, 9-14 and 16-22 are pending in the application. Claims 1-7, 9-14 and 16-22 stand as rejected. The Examiner's rejections are addressed below in substantially the same order as in the office action.

### ***Response to Amendment***

At paragraph 1 of the office action, the Examiner under the heading "Response to Amendment," deemed the declaration under 37 CFR 1.132, filed August 7, 2008, to be insufficient to overcome the rejection of claims 1-7, 9-14, and 16-22, as set forth in the last Office action because "no *evidence* has been provided." The Examiner further states that the declaration merely reiterates the arguments set forth in the response.

The subject declaration was submitted because of a basic disagreement with the Examiner regarding the interpretation of the meaning of the prior art. By means of the declaration, the Applicants established that that Dr. Larry S. Corley, the declarant, was more than one of ordinary skill in the art and was in fact a scientist holding a PhD who has worked more than 30 years and holds many patents in the field of epoxy resins; in short an expert in the field of the invention. The Applicants respectfully assert that due consideration and weight should be given to the declaration of an expert such as Dr. Corley.

### ***Response to Arguments***

In the Examiner's response to the arguments of the last response, the Examiner indicated that the Applicants' arguments in regard to Schwartzer and Alvino were persuasive and withdrew the rejections based upon same. The Applicants thank the Examiner for withdrawing the rejections.

Claims 1-4, 9-14, and 16-22 stand as rejected under 35 U.S.C. 103(a) as being unpatentable over Thoseby et al. (US Pat. No. 5,304,662). Claims 1-4, 9-14, and 16-22 also stand as rejected under 35 U.S.C. 103(a) as being unpatentable over Bagga (US Pat. No. 4,284,574).

Bagga was the subject of an anticipation rejection made by the examiner in the office action filed December 27, 2007. The claims were broader then, but the rejection was still traversed by the applicants by using the argument that the Bagga reference does not disclose the use of brominated epoxy resins. The Examiner accepted this argument and withdrew the rejection.

Bagga was not cited by the Examiner in the Office Action mailed on 06/27/2008

The Examiner has now cited both Bagga and Thoseby for substantially the same reasons as rendering the claims obvious. The Applicants respectfully traverse these rejections.

The basis for the Applicant's traversal is that the Examiner has cited a mere laundry list that would not permit one skilled in the art to immediately envisage the claimed invention. The Applicant turns to MPEP for guidance on this issue:

A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not "reasonably lead" those skilled in the art to any particular species)[.]

**MPEP Manual of Patent Examining Procedures § 2163 (August 2006 Release)**

The Examiner cites Column 6, lines 47-57 of Thoseby and Column 8, lines 55-65 for disclosing that the Examiner's references can be prepared with brominated epoxy resins, in general and 2,2-bis(3,5-dibromo-4-hydroxy-phenyl)-propane resins in specific. The passages cited by the Examiner are identical in each patent and read:

hydroxyethylamino)diphenylmethane. Preferably the polyglycidyl ethers are derived from substances containing two or more phenolic hydroxy groups per molecule, for example, resorcinol, catechol, hydroquinone, bis(4-hydroxyphenyl)methane, 1,1,2,2-tetrakis(4-hydroxyphenyl)ethane, 4,4'-dihydroxydiphenyl, bis(4-hydroxyphenyl) sulphone, and especially, phenol-formaldehyde or cresol-formaldehyde novolac resins, 2,2-bis(4-hydroxyphenyl)propane (otherwise known as bisphenol A), and 2,2-bis(3,5-dibromo-4-hydroxyphenyl)-propane.

While necessarily there is always some degree of hindsight reconstruction in rejecting a claims based upon obviousness, the Examiner has not fairly cited the art in preparing this rejection. **Possible** epoxy resins that are alleged to useful in both of the Examiner's references actually start, in Bagga, at column 8, line 7 and runs to Column 9, line 33. The identical listing in Thoseby starts at Column 5, line 67 and runs through Column 7, line 23. This section of these patents lists numerous classes of compounds and many specific compounds. Terms such as "more suitable," "especially," "preferably," and "especially suitable," were used 5 times, so even these terms cannot be used as indicators that would lead one to the "golden" few. Further, in all of these compounds, there was only one single and solitary brominated compound. Which is more likely, that a person of the art would be drawn toward this compound and away from all of the others or would that person be more likely to make a determination that the brominated compound was included in error?

In either case, one of ordinary skill in the art would hardly have been able to immediately envisage the claimed invention. To the contrary, the term "undue

experimentation" doesn't begin to cover the lab work required before one would have reproduced or been led to the present invention. One of ordinary skill in the art would have read the text cited by the Examiner as being nothing more than boiler plate.

Such a reading would have been reinforced had that person of the art seen both of the Examiner's references. The references cited have what appear to be identical passages that extend: for Bagga from Column 6, line 30 to Column 9, line 66; and for Thoseby from Column 4, line 23 to Column 7, line 54. One of ordinary skill in the art would have considered these passages as nothing more than Ciba-Geigy boiler plate. The invention as presently claimed would not have been obvious to one of ordinary skill in the art in view of either of the examiner's references.

Claims 5-7 stand rejected as under 35 U.S.C. 103(a) as being unpatentable over Thoseby or Bagga in view of Alvino, et al. (US Pat. No. 4,327,143). The Examiner cites Alvino for teaching claimed substrate not disclosed in the Examiner's primary references. Since Claims 1 and 20, the independent claims are not obvious over the Examiner's primary references, this secondary reference cannot function to render these claims as obvious.

## CONCLUSION

For all the foregoing reasons, the Applicants submit that the application is in a condition for allowance. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned at (713) 243-8711 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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